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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,205	01/16/2002	Masaya Hiramitsu	Q68085	2511
23373	7590	10/20/2003	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037			WYROZEBSKI LEE, KATARZYNA I	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/046,205	<b>Applicant(s)</b> HIRAMITSU, MASAYA	
	<b>Examiner</b> Katarzyna Wyrozebski Lee	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0603</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by SANDSTROM (US 5,901,766).

The prior art of SANDSTROM discloses composition for a tire tread of a pneumatic tire. According to the example 4 of the prior art of SANDSTROM following is rubber and resin composition:

15	Samples	4
	E-SBR <sup>1</sup>	50
	Polybutadiene <sup>2</sup>	50
	Cumarone Indene Resin <sup>3</sup>	7.5
	Phenol/Acetylene Resin <sup>4</sup>	7.5
20	Processing Oil <sup>5</sup>	31.25
	Max Torque (dNm)	28.4
	Min Torque (dNm)	5.6
	Delta Torque (dNm)	22.8
	T90 (min)	14.0
25	<u>Stress-Strain, 18 min/150° C.</u>	

Wherein cumarone indene resin is utilized in amount of 7.5 pbw. In addition bound styrene content in the composition above is:

<sup>1</sup>An emulsion polymerized styrene/butadiene rubber containing 23.5 percent by weight bound styrene, T<sub>g</sub> = -55° C., ML1 + 4 (100° C.) = 50, containing

as disclosed underneath the same table II in col. 8.

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The fillers in the prior art of SANDSTROM are not disclosed in Table II, however specification discloses use of both silica and carbon black. Silicas can be utilized in amount of 15-80 pbw (col. 4, lines 36-38) and carbon blacks can be utilized in amount of 5-125 pbw (col. 5, line 20).

The vulcanization accelerators in the examples are utilized in amount of 1.55 pbw. Although examples disclose sulfenamide, the specification teaches that preferred accelerators in addition to sulfenamide include thiuram (col. 6, lines 8-9).

In the light of the above disclosure, the prior art of SANDSTROM clearly anticipates the requirements of claims rejected above.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over SANDSTROM (US 5,901,766).

In addition to the discussion in paragraph 2 of this office action, the prior art of SANDSTROM renders claim 6 obvious for following reasons:

Although the particular ratio of carbon black to silica being 45/20 to 30/35 are not disclosed, such would have been obvious to one having ordinary skill in the art. Table I of SANDSTROM teaches use of carbon black in 70 pbw. This would suggest that the amount of reinforcing filler should not exceed 70 pbw. Therefore combination of carbon black and silica which add up to no more than 70 pbw would have been obvious to one having ordinary skill in the art.

Carbon black and silica are both reinforcing fillers widely utilized in tire industry. Their use is as the name speaks to reinforce rubber composition, what is they are utilized for the same purpose.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize carbon black and silica in appropriate ration and thereby obtain the claimed invention. It is well settled that it is prima facie obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Linder* 457 F.2d 506,509, 173 USPQ 356, 359 (CCPA 1972).

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During approximately December 4<sup>th</sup> through December 18<sup>th</sup>, the USPTO will be moving to a new building in Alexandria, wherein new phone numbers will be given. The new phone number for the examiner of record is 571-272-1127.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Katarzyna Wyrozebski Lee*  
Katarzyna Wyrozebski Lee  
Primary Examiner  
Art Unit 1714

October 15, 2003